

REMARKS

I. Introduction

The Current Action:

Objects to claims 1-9, 19, and 20 for informalities;
Rejects claims 1, 2, 6-8, and 10-13 under 35 U.S.C. § 102(b); and
Rejects claims 3-5, 9, and 14-20 under 35 U.S.C. § 103(a).

This Response:

Amends claims 1, 2, 10, and 19; and
Adds claims 21 and 22.

Support for the clarifying amendments to claims 1, 10, and 19, and for new claims 21 and 22, can be found, among other places, in the specification at pages 7 and 8. No new matter has been added. Claims 1-22 are pending in the present application, and the Applicants respectfully submit that the arguments and amendments of this response traverse all outstanding objections and rejections. The Applicants respectfully ask the Examiner to withdraw the objections to claims 1-9, 19 and 20, withdraw the rejections to claims 1-20, and to pass the application to issue.

II. The Objections to Claims 1-9, 19, and 20.

Claim 1 has been amended to change “said at least one converter” to “said converter,” as recommended by the Current Action. Claim 19 has been amended to provide antecedent basis for “said digital storage medium.” The Applicants respectfully submit that these amendments overcome the objections to claims 1 and 19. The objections to claims 2-9 and 20 are based solely on their dependence from claims 1 and 19, thus the Applicants respectfully submit that the above amendments overcome these objections as well. Therefore, the Applicants respectfully ask the Examiner to withdraw the objections to claims 1-9, 19, and 20.

III. The Rejection of Claims 1, 2, 6-8, and 10-13 Under 35 U.S.C. § 102(b)

The current Action rejects claims 1, 2, 6-8, and 10-13 as being anticipated by Lang, U.S. Patent No. 4,963,995 (hereinafter *Lang*). The Applicants respectfully submit, however,

that each of these claims contain limitations that *Lang* does not teach, and respectfully remind the Examiner that, in order to be anticipatory, M.P.E.P. § 2131 requires a reference to teach each and every limitation of the rejected claims.

Claim 1 recites “at least one recorder employing a removable digital storage medium.” The Current Action relies on memory 13 of *Lang* to meet the “digital storage medium” of claim 1, and while the Applicants do not concede that memory 13 is a “digital storage medium” as conceived by claim 1, the Applicants respectfully assert that *Lang* does not teach memory 13 to be removable. Rather, *Lang* teaches memory 13 to be a permanent fixture providing temporary storage of audio/video data, and, thus by design, is not “removable.” Therefore, the Applicants respectfully assert that *Lang* does not teach each and every limitation of claim 1, and respectfully ask the Examiner to withdraw the rejection of record to claim 1.

Claim 10, as amended, recites “inserting a removable digital storage medium into said container.” The Current Action relies on memory 13 of *Lang* to meet the “digital storage medium” of claim 10, and while the Applicants do not concede that memory 13 is a “digital storage medium” as conceived by claim 10, the Applicants respectfully assert that *Lang* does not teach memory 13 to be removable. Rather, *Lang* teaches memory 13 to be a permanent fixture providing temporary storage of audio/video data, and thus by design, memory 13 is not “removable.” Therefore, the Applicants respectfully assert that *Lang* does not teach each and every limitation of claim 10, and respectfully ask the Examiner to withdraw the rejection of record to claim 10.

Claims 2, 6-8 depend directly from claim 1 and claims 11-13 depend directly from claim 10. Thus each of claims 2, 6-8, and 10-13 inherit all of the limitations of their respective base claims. Therefore, claims 2, 6-8, and 10-13 each contain limitations not taught by *Lang*, and the Applicants respectfully ask that the Examiner to withdraw the rejection of record for claims 2, 6-8, and 10-13.

IV. The Rejection of Claims 3-5, 9, and 14-20 under 35 U.S.C. § 103(a)

The Current Action rejects claims 3-5, 9, and 14-20 as obvious in light of *Lang* and a series of Official Notices. The Applicants respectfully remind the Examiner that M.P.E.P. §

2143 requires an obviousness rejection to meet three basic criteria before it establishes a prima facie case. First the rejection must recite motivation for combining the references proposed that is either found in the references themselves or that was generally known to those of ordinary skill in the art at the time the invention was made. Second, the combination must have inspired a reasonable expectation of success. Third, the combination must teach or suggest each and every limitation of the rejected claims. Without conceding that the Current Action establishes any of the criteria, the Applicants respectfully assert specifically that the Current Action fails to demonstrate that its proposed combinations teach or suggest each and every limitation of the claims 3-5, 9, and 14-20, and fails to provide adequate motivation for the combinations used to reject claim 19 and 20.

Claims 3-5 and 9 depend either directly or indirectly from claim 1, thus each inherits all of the limitations of claim 1. As demonstrated above, *Lang* does not teach or suggest the removable digital storage medium required by claim 1, thus *Lang* does not teach or suggest all of the limitations of claims 3-5 and 9, either. None of the Examiner's proposed Official Notices address these omitted limitations, thus the Current Action fails to demonstrate that its proposed combination teaches or suggests all of the limitations of claims 3-5 and 9. The Applicants respectfully ask the Examiner to withdraw the rejection of record to claims 3-5 and 9.

Claims 14-18 depend either directly or indirectly from claim 10, thus each inherits all of the limitations of claim 10. As demonstrated above, *Lang* does not teach or suggest the removable digital storage medium required by claim 10, thus *Lang* does not teach or suggest all of the limitations of claims 14-18 either. None of the Examiner's proposed Official Notices address these omitted limitations, thus the Current Action's rejections of claims 14-18 have failed to demonstrate that its proposed combinations teach or suggest all of the limitation in claims 14-18. Therefore, the Applicants respectfully ask the Examiner to withdraw the rejections of record for claims 14-18.

Claim 19, as amended, recites "one of a CD recorder and a DVD recorder for storing said digital data onto at least one inserted digital storage medium, thereby transferring said analog video from said inserted cassette to said inserted digital medium." The Applicants respectfully assert that *Lang* does not teach or suggest this limitation, but, rather, that *Lang*

teaches an apparatus for the transfer of data from one removable storage medium to another removable storage medium of the same type. The Current Action concedes that *Lang* fails to teach either a CD recorder or a DVD recorder as the digital storage medium 13, but opines:

Lang also discloses in column 6, lines 8-19 that different types of memory technologies are adaptable for use in memory 13 such as DRAM, SRAM, CMOS, and optical disc memories.

It is noted that CD recorder or DVD recorder is old and well known in the art and; therefore, Official Notice is taken.

Current Action pages 11-12. However, even if this alteration of *Lang* is accepted, the altered apparatus of *Lang* would still not meet the limitation of claim 19. Changing the internal, non-removable memory 13 to a CD recorder or a DVD recorder still merely provides temporarily data storage for an eventual transfer back to media 23. Thus, it still does not provide “one of a CD recorder and a DVD recorder for storing said digital data onto at least one inserted digital storage medium, thereby transferring said analog video from said inserted cassette to said inserted digital medium, wherein said video cassette player, said analog to digital converter, and said digital storage medium are disposed within a single container.” Therefore, even when combined, *Lang* and the Official Notice do not teach or suggest all of the limitations of claim 19 and fail to establish a prima facie case. The Applicants respectfully ask the Examiner to withdraw the rejection of claim 19.

In addition, no adequate motivation is given for the alteration the Examiner proposes to make to *Lang*. In rejecting claim 19, the Current Action opines:

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the well-known CD recorder or DVD recorder into *Lang*’s system since it merely amounts to selecting an alternative equivalent recording device because *Lang* teaches that different recording devices can be used.

Current Action page 12. However, the Applicants respectfully assert that neither CD recording nor DVD recording would be suitable replacements for memory 13 of *Lang*. As the Examiner notes, the formats *Lang* teaches for memory 13 are DRAM, SRAM, CMOS, and optical discs. *Lang* envisions suitable replacements for these memory types wherein “Emerging technologies may also prove advantageous with capabilities for mass storage in

even small physical dimensions.” *Lang* column 6 lines 20-22. The Applicants respectfully assert that neither CD recording nor DVD recording is capable of mass storage in physical dimensions as small as those already taught by *Lang*. Thus, there would be not motivation for substituting these formats. Further, if *Lang* were altered to utilize CD or DVD recordable memory as memory 13, memory 13 would be bulkier, slower, more expensive, and less capable of repeated use. This would render it unsuitable for *Lang*’s intended purpose; namely the temporary storage of data from media 23 for the eventual re-recording onto media 23. Therefore, no motivation exists for making the alterations proposed, and the Current Action fails to establish a prima facie case for rejecting claim 19. The Applicants respectfully ask the examiner to withdraw the rejection.

Claim 20 depends directly from claim 19, thus inherits all of that claim’s limitations. As shown above, *Lang* and the Official Notices fail to teach or suggest all of the limitations of claim 19, thus the combination fails to teach or suggest all of the limitations of claim 20 as well. The Applicants respectfully ask the Examiner to withdraw the rejection of record for claim 20 as well.

V. New Claims

This response adds new claims 21 and 22. The Applicants respectfully submit that these claims are patentable over the art of record, and respectfully ask the Examiner to pass them to allowance.

VI. Conclusion

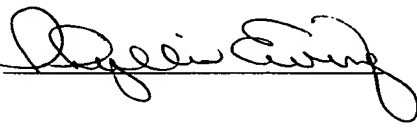
In view of the above amendment, Applicants believe the pending application is in condition for allowance.

Applicants believe that a fee \$36.00, for the addition of two new claims, is due with this response. However, if this amount is incorrect, please charge Deposit Account 08-2025, under Order No. 10981001-1 from which the undersigned is authorized to draw.

I hereby certify that this correspondence is being deposited with the U.S. Postal Service as Express Mail, Airbill No. EV482735231US, in an envelope addressed to: MS Amendment, Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450, on the date shown below.

Date of Deposit: October 7, 2004

Typed Name: Phyllis Ewing

Signature: 

Respectfully submitted,

By 

Michael A. Papalas

Attorney/Agent for Applicant(s)

Reg. No.: 40,381

Date: October 7, 2004

Telephone No. (214) 855-8186